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Comments and suggestions are welcome by e-mail to ruth.nyblod@uspto.gov.



Nicholas P. Godici

Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

Budget-related issues are a hot topic at this time of year. The USPTO is currently involved in three different budget years: the execution of the current fiscal year 2001 budget, the final appropriations and allocations for the upcoming fiscal year 2002 budget, and the start of the planning process for the fiscal year 2003 budget. While this is an annual task, it is unique this year because of the change in administration. Our budget is directly linked to the agency's priorities, and the new administration brings a new set of priorities. President Bush has recently released his blueprint for government reform. The president's three key concepts are citizen-based, results-oriented, and market-based government.

Citizen-based government means flattening the federal hierarchy, and using the Internet and e-government initiatives for citizen-centric government. In the past few years there has been a growing focus by the USPTO on our customers and the users of the intellectual property system. We have implemented a number of systems, including Web site access to free patent and trademark databases and also our electronic filing systems, just to name two, that align with this objective. By using customer surveys and a variety of other customer feedback mechanisms, we will continue to identify and pursue new ways to be more citizen-centered and better serve our customers.

Making government results-oriented includes linking budget management decisions to performance. Since the re-establishment of the USPTO by the American Inventors Protection Act legislation, one of our key priorities has been management-by-performance. We have instituted performance scorecards for each organization and have based the evaluation of our senior managers on the achievement of their performance targets. This objective also includes making our service contracts performance-based by includ-

ing performance expectations into our contracts. We look forward to continuing to enhance performance measures and results not only into our daily management, but also into budget planning and agency priorities.

Making the government market-based refers to procurement and contracting out activities. Specifically, it includes making e-procurement the government-wide standard and opening government activities to competition. The USPTO has been involved in e-procurement activities for over three years and continues to pursue ways to use the Internet for more efficient procurement processing. In addition, we have been very active in using contracting for non-inherently government functions. We will continue to pursue ways to be more efficient in our operations and business activities.

The key concepts of these objectives fit very well into the current business and strategic direction of the USPTO, and we look forward to revalidating and aligning our business and budget priorities to support these objectives.

This reform is based on an “active, but limited” government that empowers citizens, ensures accountability, and promotes innovation through competition.

USPTO Publishes First Patent Applications

by Maria V. Hernandez, Office of Public Affairs

On March 15, the United States Patent and Trademark Office published its first set of patent applications under the American Inventors Protection Act, a 1999 law making far-reaching changes to the U.S. patent system.

Publication of patent applications before a patent is granted is one of the most fundamentally significant changes to the U.S. patent system in over 100 years. Published applications will become an important reservoir of reference materials for patent examiners and a valuable resource to the public as the volume of published applications increases.

Forty-seven applications were published in a variety of technical fields including surgical devices, chemical processes, and business

methods. The published patent applications may be viewed as images or text searched at <http://www.uspto.gov/patft/index.html>. New applications are published every Thursday. The number of patent applications published by USPTO is anticipated to increase over the next 18 months until roughly 3,500 applications are published weekly.

Publication of patent applications is now required for the vast majority of filings made on or after November 29, 2000. Publication occurs after expiration of an 18-month period following the earliest effective filing date. The earliest effective filing date may be influenced by a number of factors, including foreign filing. Previously U.S. patent applications were held in confidence until a patent was granted, while other major patent offices around the world have a history of publishing patent applications. An application will not be published if an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires 18-month publication.

An important procedure under the new law allows an inventor to request early publication of an application. The first group of published applications includes one published at the inventor's request. This application was filed in June 1999 and, therefore, was not required to be published. By requesting voluntary publication, the applicant will enjoy the potential benefit of provisional rights to reasonable royalties from others who make, use, sell, or import the invention during the period between the time the patent application is published and the patent is granted.

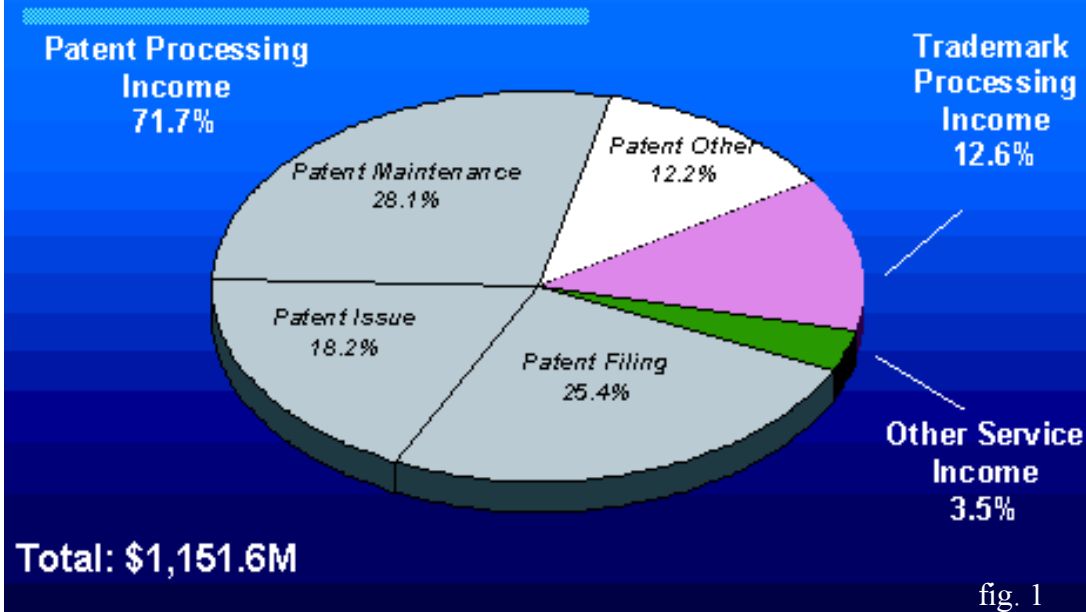
WHERE DOES THE MONEY GO?

by Barry Riordan, Senior Economist, Office of Corporate Planning

In fiscal year 2000, the USPTO for the first time exceeded \$1 billion dollars in fee collections. By any measure, this is a lot of money and those paying these fees, as well as the American public as a whole, have a right to expect that these fees will be spent in a prudent manner.

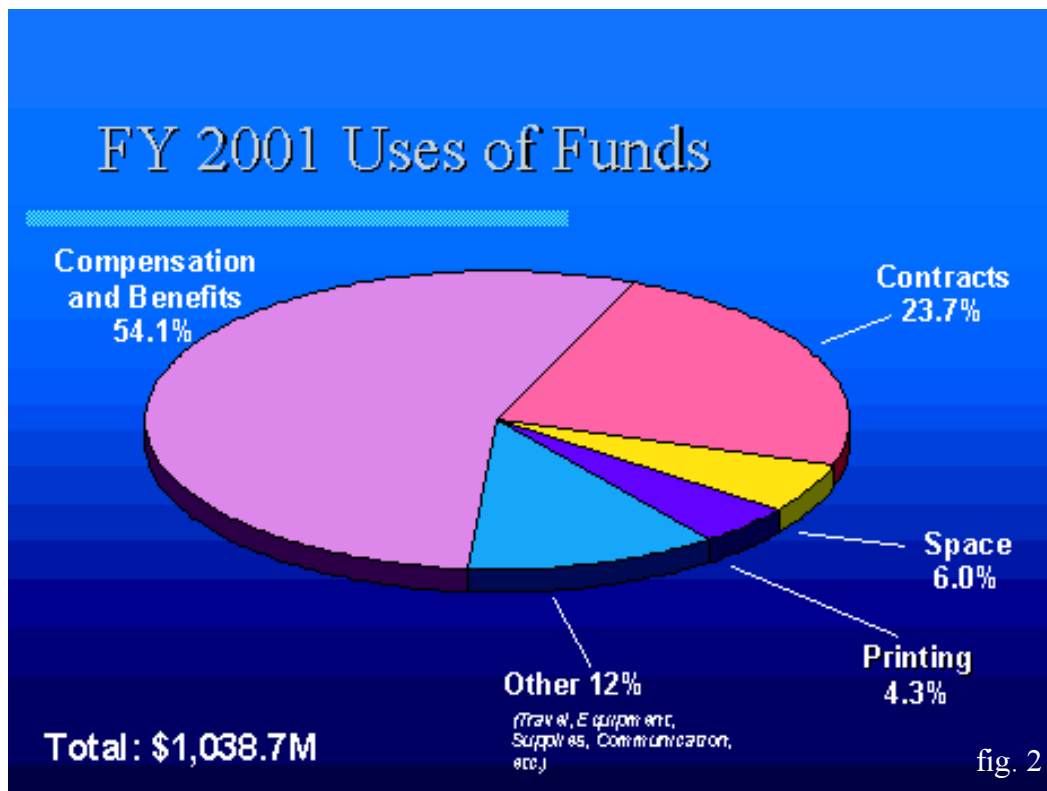
First, where exactly do USPTO fees come from? As shown in figure 1, in this fiscal year USPTO expects patent processing

FY 2001 Fee Collections



income to compose almost two-thirds of the total, with trademark processing income and other income representing the remainder. The largest single fee category is patent maintenance fees — those fees that are collected over the term of an issued patent, in years 4, 7 and 11. Maintenance fees make up about 26 percent of the fee total, while the second largest category, patent application fees, represent about 24 percent. In this fiscal year, 2001, these two fee categories alone will total more than \$566 million.

The USPTO spends its money mainly on people (see figure 2). Of the agency's total budget for fiscal year 2001, 56 percent goes to pay compensation and benefits for the more than 6,000 USPTO employees. In addition, most of the \$271 million that will be spent through contracts is for labor. These contracts cover many different essential functions, such as the development of information technology, publication of the *Official Gazette* and other information vehicles, and access to commercial databases. Overall, the USPTO annual budget highlights a continuing reliance on highly skilled professionals — scientists, engineers, lawyers, and computer specialists. The remainder of the budget is spent on such items as office space, travel, computer and office equipment, printing, and miscellaneous supplies.



Note that for fiscal year 2001, the USPTO is shown to be spending less than the fees it collects. This is because, unlike a commercial entity, the USPTO is not permitted to spend any of its collections unless they are appropriated by legislative action. Typically, over the past several years, the Congress has appropriated amounts less than fees collected. The unappropriated fees have for the most part been “carried over” and are available for use in future years. In any fiscal year, the funds appropriated by Congress contain a mixture of current and past years’ collections.

USPTO Expands Its Horizons in *Telecommuting*

by Debbie Cohn, Office of the Commissioner for Trademarks

The United States Patent and Trademark Office is focusing on telecommuting as a way to run its business. What started as a pilot for 18 attorneys is now a telecommuting program for 90 trademark attorneys at the USPTO.

A family-friendly workplace, the USPTO hopes to greatly expand the use of alternative work site options for an increasing percentage of its employees in a greater number of positions. This year, the agency will further expand its telecommuting program to include approximately 110 of its 420 trademark attorneys, and also will pilot additional positions for the work-at-home environment.

The agency, in partnership with the National Treasury Employees Union,

has been operating a work at home program for trademark attorneys since 1997.

Reported results show that the work-at-home arrangement favorably impacts productivity and morale.

As suburban sprawl and crowded highways become an everyday reality in the Washington metropolitan area, employers and employees are looking to telecommuting as a way of doing business for the future. In October 2000, the federal government mandated that agencies participate in telecommuting as means to reduce traffic congestion (Section 359 of Public Law 106-346). Another primary goal of the USPTO program is to make additional space available in an agency that has seen its workload increase greatly over past years. In addition, providing a better quality of work life for employees will enable the organization to attract and retain highly-qualified employees.

The USPTO's comprehensive guidelines have been used as a model for other federal agencies and private companies. The expanded program includes training for supervisors and participants and specific guidance on administrative, customer service, and performance issues.



Margery Tierney, Law Office 107, and John Dalier, Law Office 105, enjoy telecommuting a couple of days a week.



To determine the success of the program, the agency looks at the following areas:

Technology: Implementing a work-at-home program in the USPTO has presented some unique challenges, primarily in the area of technology. Trademark examining attorneys work in a production environment using one-of-a-kind automated search and research tools contained in a number of live databases. The program involves the set up of a complete desktop work environment at participants' homes, enabling them to perform all of their job functions from a remote location. The pilot experience highlighted some areas where technology improvement was necessary, including the need to move away from costly ISDN connections. The new system architecture is based on Internet connections which is more cost-effective for people outside the local calling area.

Performance and customer service: Compared with a control group of trademark examining attorneys in the office, pilot work-at-home employees were able to maintain or exceed performance goals. On average, productivity was higher for those working at home for part of the week than for the average employees in the central office. In addition, an independent customer telephone survey showed that work-at-home employees were able to provide the same high level of customer service as employees who remained in the office. As the program has expanded, performance measures continue to show high productivity for employees who telecommute.

Labor Relations: All aspects of the program were developed and implemented in partnership with the National Treasury Employees Union Chapter 245 and through the USPTO Partnership Council. A labor/management partnership working group continues to provide oversight over the expanded program. The working group has been one of the most successful partnership efforts in USPTO history, and serves as a model for future endeavors in partnership between agency management and union representatives.

Employee satisfaction: For the employee, there are many benefits to telecommuting. Most telecommuters report they get more done and are more satisfied with their jobs as a result of telecommuting. The shortened commute decreases employee travel expenses and commuting stress, while enhancing the quality of work life and increasing the amount of time telecommuters have for family life and personal pursuits. Telecommuters also enjoy a greater degree of work-related autonomy and responsibility.

Pilot participants made the following comments during evaluation sessions:

“The Flexiplace work at home program has saved me from two hours commuting time each day I worked at home. Instead of commuting to work I could put breakfast on the table, walk my 10 year old to elementary school, drive the morning carpool for my 13 year old’s middle school, and still start work earlier than I could when commuting to work.”

“The single most significant benefit to me has been a wholesale improvement in morale. There is absolutely no comparison between the way I feel on my work-at-home days vs. in-office days. The work environment here at my rural Maryland home, with the view of mountains, trees, and wildlife, possesses a general peace/quiet which is a far cry from the urban office environment and, in my opinion, a vast improvement. Participation in this program has probably extended my PTO career. [P]rior to the announcement of the TWAH pilot, [I] seriously considered leaving the PTO or requesting part-time status. Since starting TWAH, these options seem less appealing.”

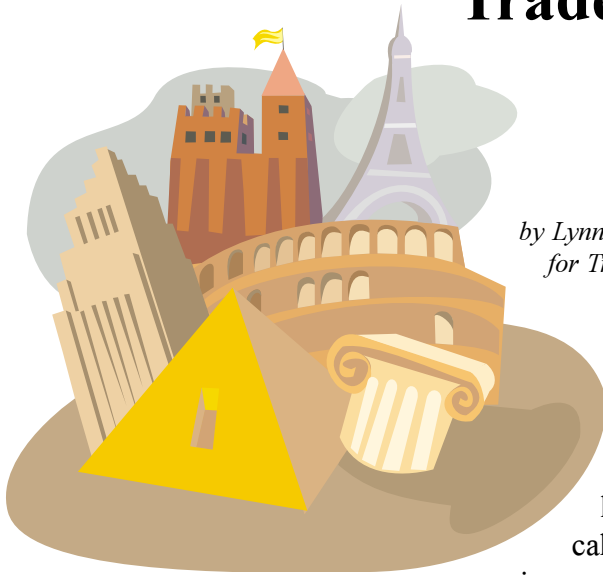
For the organization, telecommuting has proven to be an effective tool for improving job performance, helping recruit and retain valuable employees, and effectively using new technology to conserve limited physical resources such as office space. The agency has also been able to accommodate disabled employees or employees with emergency circumstances while they continue productive work. It is clearly a win-win situation for the agency and its employees.

Notice

The Patent and Trademark Museum is closed for the month of April. When it reopens in May it will sport a brand new look, have a gift shop, and be under new management.

The National Inventors Hall of Fame, headquartered in Akron, Ohio, will manage the day-to-day operations of the museum and gift shop. The shop will be open Monday through Friday and will sell a variety of USPTO logo merchandise. Proceeds from the sale of merchandise help support joint educational outreach efforts sponsored by the USPTO and the National Inventors Hall of Fame. The new exhibit will feature the big scoop on ice cream inventions and trademarks.

Geographical Indications and Trademarks



*by Lynne Beresford, Deputy Commissioner
for Trademark Examination Policy*

The United States has a long history of protecting geographical terms as trademarks, certification marks, and collective marks. Two of the oldest certification marks on the U.S. Principal Register are “GROWN IN IDAHO” (Reg. No. 0631499, registration date July 24, 1956) for potatoes, and “ROQUEFORT” (Reg. No. 0571798, registration date March 10, 1953) for cheese. In other parts of the world, these certification marks, “GROWN IN IDAHO” and “ROQUEFORT,” would be eligible for protection, and could perhaps only be protected, as “geographical indications” rather than as trademarks.

The 1994 Agreement on the Trade Related Aspects of Intellectual Property (TRIPs Agreement) provided that geographical indications must be protected as intellectual property. Prior to the TRIPs Agreement, it was not particularly clear that geographical indications were intellectual property. In some countries, geographical indications were creatures of specific statutory protection, owned by the government and used by individual or collective producers on terms dictated by the government. In other countries, geographical indications were protected as collective marks, trademarks, or not protectible at all.

The TRIPs Agreement also provided its own definition of geographical indications. That, too, was a step forward. In the past, geographical indications might be referred to as “appellations of origin,” “geographical indications,” or as “indications of origin.” Each term carried its own definitional baggage and the meaning of the terms might vary from jurisdiction to jurisdiction or from one international agreement to another.

Article 22(1) of the TRIPS Agreement defines a geographical indication (GI) as:

Geographical indications are indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographic origin.

The TRIPS Agreement requires that World Trade Organization (WTO) Members provide the legal means for interested parties to prevent the use of a GI that: (1) indicates or suggests that a good originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; or (2) constitutes an act of unfair competition. The TRIPS Agreement also provides for an “enhanced” minimum level of protection for GIs that identify wines and spirits. WTO Members are required to provide the legal means for interested parties to prevent the use of GIs even if they imply that the wines or spirits originate in a place other than the true place of origin. In other words, for wines and spirits, even if the public would not be deceived by use of a particular GI, a GI may not be used if the wines or spirits do not originate in the place indicated by the GI.

Geographical indications, whether protected as trademarks or by other means, can be just as valuable as any trademark. For example, “Florida Orange Juice” and “Cognac” brandy are both products that are identified by their geographical indication. The producers know that the public trusts that geographical indication, or trademark in U.S. parlance, and buys accordingly.

On the international scene, many countries are struggling to determine how to best protect their own geographical indications both in their own country and in other countries. Because the United States relies on its trademark system, the process is relatively straightforward, as far as the United States is concerned. The “owner” of the geographical indication, which can be an association, a group of producers, or a governmental body, need only apply for protection as a certification or collective trademark. But in those countries where the state “owns” and controls the use of geographical indications, the authority responsible for protecting and enforcing the country’s geographical indications often doesn’t have a clue about seeking trademark protection, and, in fact, may find it very strange to have to take any measure to get what obviously seems to the authority to be “national” property protected in another country. On the other hand, in those countries where protection is granted only if there is governmental approval of production methods, quality control and statutory definitions, a

U.S. producer may find it impossible to get protection for its geographical indication/certification mark.

The issue of protecting geographical indications and trademarks and the relationship between the two is also very unsettled internationally. In some countries, geographical indications are considered so important, and so much a part of the national heritage, that even a geographical indication whose use arises after a conflicting trademark is registered and becomes well known, can be used to cancel the registration and prohibit the use of that trademark. This is clearly a problem for the U. S. trademark owners. Looking at geographical terms around the world, one sees that there are many geographical terms that sound like, or look like, well-known U.S. trademarks.

In the end, however, if there is to be a rational and effective way to ensure rights in trademarks and geographical indications, each national system needs to be set up to respect the rights of businesses in their valuable intellectual property and provide certainty as to how rights will be protected. No business wants to invest in and promote a trademark only to lose its exclusive right to use that mark to a geographical indication that appears after the trademark owner has created good will in the market. Nor does the owner of a U.S. certification mark want to find that it cannot protect its valuable rights in its geographical indication because a third country does not recognize any rights in a geographical indication that arise from a certification mark.

From the Editor

Because of budget constraints, we will no longer publish a quarterly edition of the *USPTO Today* in print. However, for those of you who subscribe to the print edition, you will be receiving a special patent edition and a special trademark edition this spring, and we plan to continue publishing the two special editions in print each year.

The special edition for patents appeared online in November 2000, and the trademark special edition will be online next month to coincide with the International Trademark Association's annual meeting.

The monthly online editions will continue without interruption, and we will continue to take subscriptions for the two yearly special editions.

Faces of the USPTO

Richard Maulsby has been director of public affairs since 1994. In that capacity he is responsible for internal and external communications related to the media, customers, and the general public at the USPTO. Under his leadership, the agency has seen an expanded educational and informational public outreach program, including the development of the Patent and Trademark Museum; a magazine, *USPTO Today*; the increased

use of video; a consistent corporate look in all graphics and publications; and a forceful proactive approach to media and press relations. He continues to work closely with the National Inventors Hall of Fame on a number of joint projects, exhibits, the annual induction ceremony, Camp Invention, and television programming. Videos produced by Mr. Maulsby for the USPTO have won awards at the Houston and Chicago Film and Video Festivals.



Prior to joining the USPTO, Mr. Maulsby held senior management positions in the District of Columbia government where he led agencies responsible for cable television and motion picture and television development. From 1968 to 1979, he worked in radio, television, and film production in Buffalo, New York, and Washington, D.C. His work has received several industry production awards including the CINE. The District of Columbia's cable channels managed by Mr. Maulsby were cited in 1989 by the National League of Cities for outstanding programming achievement.

Mr. Maulsby holds a B.A. in Radio-TV from the University of Nebraska, and a Master's degree in Communication and Mass Media from the State University of New York at Buffalo.

Helpful Hints

for patent applicants

Editor's note: Instead of the regular helpful hints we provide in this column, we bring to your attention an opportunity to comment on issues related to the harmonization of patent laws.

International Effort To Harmonize Substantive Requirements Of Patent Laws

Independent inventors have the opportunity to comment on a wide variety of issues that the United States will be discussing at the May 2001 meeting of the Standing Committee on the Law of Patents (SCP) at the World Intellectual Property Organization (WIPO) in Geneva, Switzerland. This comment period ends on April 30, 2001. Send written comments to Director of the USPTO, Box 4, Washington, DC 20231, Attn. Mr. Jon Santamauro; or fax to Mr. Santamauro at [703]305-8885; or e-mail at scpcomments@uspto.gov.

The purpose of the harmonization discussions is to achieve uniform treatment of patent applications and patent grants, thereby resulting in lower costs to obtain and enforce patents in the different countries of the world. The USPTO issued a *Federal Register* notice highlighting 17 issues for public comment, and it is recommended that independent inventors carefully read and study each of the issues in detail. However, comment is welcome on any aspect of the treaty text or process of patent law harmonization. A copy of the *Federal Register* notice is available on the USPTO Web site at <http://www.uspto.gov/web/offices/com/sol/notices/intpatlaws.pdf>. The texts of the most recent draft treaty documents are available at the end of the notice.

This memo is merely intended to highlight the issues discussed in the notice. When commenting on a specific issue, you should use the issue number in your commentary. Any additional comments may be submitted under the heading, "Other Comments."

- 1. Priority of invention:** The United States is a first-to-invent system while the remainder of the world uses a first-to-file system.
- 2. Patentable subject matter:** The United States currently provides a test of whether the invention is within one of the statutory categories of 35 U.S.C. §101 and within the "useful arts"

as expressed in the U.S. Constitution. The “useful arts” test requires that the claimed invention must have a useful, concrete, and tangible result. In contrast, the patent laws of some countries require that the invention provide a “technical contribution.”

3. **Specification, 35 U.S.C. 112, first par.:** The United States provides for a written description, enablement, and best mode requirement, while the standards vary among the other patent systems as to disclosure requirements.
4. **Claims:** The United States has no requirement to identify the technical field to which the claimed invention relates. While some countries require the identification of a technical field, they may limit, to some degree, the categories of invention to which claims may be directed.
5. **Restriction:** When there are multiple inventions claimed in a single patent application, the United States uses a restriction practice based on independence and patentable distinctness between the claimed inventions, while most of the world uses the Patent Cooperation Treaty (PCT) standard of “unity of invention.”
6. **Utility under 35 U.S.C. 101:** The United States requires that the utility of an invention must be specific, substantial, and credible, while most other countries use a narrower standard called industrial applicability, meaning that the invention must be usable in any industry.
7. **Priority date:** Pursuant to 35 U.S.C. §102(e), the United States limits the prior art effective date of U.S. patents and applications to their effective filing date in the United States and limits the prior art date of foreign patent publications to their publication date, although international publications are available as of their filing date if published in English. The draft treaty would implement a global priority date based upon an agreed to publication or patent grant date.
8. **Use of patent applications as prior art:** The United States allows the use of patent applications as prior art for both novelty and obviousness considerations, provided the application is earlier filed and is published or granted, while other systems restrict the use of these applications to questions of novelty only.
9. **Disclosure during the “grace period”:** Pursuant to 35 U.S.C. §102(b), the United States has a grace period prior to filing the patent application during which the inventor may make disclosures about his invention and NOT risk defeat of his patent application, while other systems prohibit any disclosures prior to the date the application is filed.
10. **Geographical limits on defining prior art:** In certain situations the United States limits disclosures to acts within a par-

ticular geographical area, e.g. within the territory of the United States, while the draft would eliminate any geographical limitation associated with prior art.

- 11. Loss of rights:** The United States provides for loss of rights for certain acts committed under 35 U.S.C. 102(b), (c), and (d), while most other patent systems do not have such provisions.
 - 12. Anticipating a claim using multiple references:** The United States permits multiple references under 35 U.S.C. 102, for example, incorporation by reference, while other patent systems have stricter requirements for the use of additional references as to the determination of novelty.
 - 13. Obviousness:** The United States follows the practice set forth in *Graham v. John Deere* and what would have been obvious to one of ordinary skill in the art, while other patent systems utilize a wide variety of determinations.
 - 14. Multiple dependent claims:** The United States has rules governing the formatting and dependency of multiple dependent claims, while other patent systems have no restrictions regarding formatting or claim dependency.
 - 15. Claim interpretation:** The United States and the rest of the patent systems differ on claim interpretation and claim construction in both the pre-grant and post-grant time periods. Is there a “best practice” available?
 - 16. Doctrine of equivalents:** The United States and some other patent systems apply a doctrine of equivalents when appropriate in interpreting claims in post-grant infringement cases, while some countries do not provide for such equivalents.
 - 17. Applicants:** The United States requires that the application be applied for in the name(s) of the inventor(s), while some patent systems allow for the direct filing by assignees. The draft treaty is silent on this issue, but it may arise in future discussions.
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USPTO 2001 Spring Video Conference Series

E-Learning Lecture Schedule

The Video Conference Center Lectures reflect the USPTO's current and largest introduction into e-learning for its patent examiner and public sector constituents. Public sector lectures are offered through the USPTO's videoconferencing facilities at partnership Patent and Trademark Depository Libraries in Sunnyvale, California; Detroit, Michigan; and Houston, Texas. Currently these are the only locations the lectures will be offered to the public.

The subjects offered mirror learning requirements in the ongoing in-house Practice and Procedures technical curriculum. Listed below is a schedule of upcoming courses for the next several months. Please remember that start times listed are Eastern Time. Each partnership PTDL site is in a different time zone, therefore you must check with them for accurate local starting times. Most lectures run about two hours, however some may go as long as three hours. The schedule of lectures is confirmed for participation at the time of publishing, however it is subject to change based upon agency needs.

<u>TITLE</u>	<u>DATE</u>	<u>TIME</u>	<u>LECTURER</u>
PCT I	April 10, 2001	1:00 PM	Carol Bidwell
PCT II	April 12, 2001	1:00 PM	Carol Bidwell
Trademark Tips for Paralegals	April 24, 2001	1:00 PM	Janice Long/ Hope Slonim
112.2 nd Paragraph	April 26, 2001	1:00 PM	Nelson Moskowitz
Novelty 35 USC 102	May 01, 2001	1:00 PM	Tom Will
Affidavits 37 CFR 1.31 & 1.32	May 10, 2001	1:00 PM	David Lacey
Re-Issue and Re-Exam	May 15, 2001	1:00 PM	Kenneth Schor/ Joe Narcavavage
Obviousness 35 USC 103	May 24, 2001	1:00 PM	David Moore
New Rule Changes	June 05, 2001	1:00 PM	Robert J. Spar
Response by Applicant	June 07, 2001	1:00 PM	Carlos Azpuru
PCT I	June 19, 2001	1:00 PM	Carol Bidwell
PCT II	June 21, 2001	1:00 PM	Carol Bidwell

Contact your closest partnership PTDL for information on times, registration fees, or to register:

Sunnyvale Center for Innovation, Invention and Ideas

Sunnyvale, California

Phone: (408) 730-7290

Great Lakes Patent and Trademark Center

Detroit, Michigan

Phone: (313) 833-3379

South Central Intellectual Property Partnership

at Rice University

Houston, Texas

Phone: (713) 348-5196

VIDEOCONFERENCE COURSE DESCRIPTIONS

Patents

Affidavit Practice: 37 CFR 1.131 and 1.132:

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference, and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be much more effective, lending credence to the old saying "it ain't what you do but the way that you do it!"

Obviousness under 35 USC 103:

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
- Hindsight;
- Motivation different from applicant's;

- Art recognized equivalence for the same purpose;
 - Physical incorporation;
 - Destroying a reference;
 - Changing principle of operation and number of references combined;
- and
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

With all this valuable information, it is “obvious” that you need to take this class!

Novelty 35 USC 102:

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

Petitions:

Every patent attorney needs to know how to handle petitions expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that **MUST** be met to have a petition granted. Become more effective in your practice before the office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

Changes to Patent Practice and Procedure - New Rules

Changes

Changes to Patent Practice and Procedure - New Rules Changes is a comprehensive lecture covering primarily the rules changes of the American Inventors Protection Act of 1999, (AIPA), and the Patent Business Goals-Final Rule, (PBG-Final Rule). The first portion of the lecture highlights some of the significant changes to patent practice and procedure wrought by passage of the AIPA and its implementation. Topics include Patent Term Guarantee, the Request for Continued Examination Practice, Pre-Grant Publication (PG-Pub), and *Inter Partes* Reexamination. The first portion of the lecture also focuses on changes to 35 USC § 103(c) and 35 USC § 102(e) and § 374 made by the AIPA.

The second portion of *Changes to Patent Practice and Procedure - New Rules Changes* addresses some of the important rules changes as published in the PBG-Final Rule. These changes are part of the office’s continuing efforts to streamline and simplify the process of applying for and obtaining patent protection for new inventions. The lecture will focus on those rules which best eliminate unnecessary requirements for applying for and obtaining a patent, remove impediments to electronic filing, reduce costs to the public and the office, and clarify previously complicated technical rules.

Lastly, a brief overview concerning other rules changes such as the changes relating to unlocatable files and payment of USPTO fees by credit card will be provided, as well as an overview of significant practice changes such as OIPE review of drawings, Electronic Filing System (EFS) submissions, and PCT CD filings.

Reexam and Reissue

The lecture provides an overview of the *ex parte* reexamination and reissue programs established pursuant to the statutes (35 U.S.C. 251 and 35 U.S.C. 302-305), rules (37 CFR 1.172-1.179 and 37 CFR 1.510-1.552), and MPEP requirements governing reissue applications and *ex parte* reexamination proceedings, respectively. The objectives include enabling the practitioner to understand reissue practice as a post-issuance activity for correcting errors in issued patents, and reexamination practice as a litigation alternative. The overview will include some policy highlights of the office's implementation efforts for optional *inter partes* reexamination. The attendee will learn:

- To understand how the key provisions of the statutes and rules apply to the examination process of reissues and *ex parte* reexaminations;
- To understand the instances where patents are eligible for *inter partes* reexamination;
- To understand the primary similarities and differences between the examinations of reissue applications, *ex parte* reexamination proceedings, and regular utility applications;
- To understand the criteria for granting a request for reexamination;
- To understand the scope of *ex parte* reexamination proceedings; and
- To recognize the importance of and the emphasis on a reissue oath/declaration and to be able to distinguish such from the oath or declaration of a utility application.

35 USC 112-2 paragraph, Rejections Not Based on Prior Art:

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

Response by Applicant:

It is very important to understand the proper form when dealing with the USPTO. It makes life easier and helps avoid delays. This session enables

the attendee to determine when a response to an Office Action is correct and complete. It will guide the applicant on the proper course of action to be taken when the response is incorrectly filed. To state it simply, it covers the who, what and when of responses-WHO is the proper person to file? WHAT is considered a proper response? And WHEN is it due?

The Patent Cooperation Treaty:

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

Patent Cooperation Treaty (PCT) Part I:

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Participants are taught how to properly fill out a PCT Request form including information on using PCT –EASY, the self-validating software for generating the Request.

Patent Cooperation Treaty (PCT) Part II:

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

TRADEMARKS

Trademark Tips for Paralegals:

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

Trademark Trial and Appeal Board Issues:

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.

Patents Customer 2001 Workshops on Electronic Government Initiatives and the American Inventors Protection Act

The USPTO has scheduled educational workshops in

- Piscataway, NJ (April 16-17),
- Dallas, TX (May 7-8),
- Grand Rapids, MI (May 14-15),
- Troy, MI (May 17-18),
- Cleveland, OH (May 21-22),
- St. Louis, MO (June 4-5),
- Minneapolis/St. Paul, MN (June 7-8),
- Orlando, FL (June 25-26), and
- Atlanta, GA (June 28-29)

to introduce the agency's patent-related electronic government initiatives and to explain rules and regulations implementing recent changes to patent law.

The electronic government segment of the workshop will show customers how to file a patent application online, using the agency's state-of-the-art electronic filing software. The system assembles all application components, calculates fees, validates application content, compresses, encrypts and transmits the filing to USPTO. The agency uses the latest public key infrastructure technology to guarantee the security of electronic applications. The session will also demonstrate how to access patent application information on line.

The second segment of the workshop will explain new USPTO procedures for implementing the American Inventors Protection Act of 1999. This segment will focus on procedures for Request for Continued Examination, Patent Term Adjustment, 18-Month Publication, and Inter Partes Reexamination. There will also be discussions about significant changes in the Patent Business Goals final rule, which simplifies patent application filing.

Reservation and contact information for USPTO's Patents Customer 2001 Program workshops:

Piscataway:

Sponsored by: Rutgers University

Location: Library of Science and Medicine

Date/Time: Monday, April 16, 2001, 9:00 a.m. - 4:30 p.m.

Tuesday, April 17, 2001, 9:00 a.m. - 4:30 p.m.

Contact: 732/445-2895 ext. 5

swamy@rci.rutgers.edu

Dallas:

Sponsored by: Dallas Public Library
Location: Dallas Public Library
Date/Time: Monday, May 7, 2001, 9:00 a.m. - 4:30 p.m.
Tuesday, May 8, 2001, 9:00 a.m. - 4:30 p.m.
Contact: 214/670-1468 or 214/670-1462

Grand Rapids:

Sponsored by: Michigan State Bar Intellectual Property Section
Location: Amway Grand Hotel
Date/Time: Monday, May 14, 2001, 9:00 a.m. - 4:30 p.m.
Tuesday, May 15, 2001, 9:00 a.m. - 4:30 p.m.
Contact: Catherine S. Collins
Phone: (616) 975-5506
Fax: (616) 975-5505
Collins@vglb.com

Troy:

Sponsored by: Michigan State Bar Intellectual Property Section
Location: Troy Marriott
Date/Time: Thursday, May 17, 2001, 9:00 a.m. - 4:30 p.m.
Friday May 18, 2001, 9:00 a.m. - 4:30 p.m.
Contact: Beverly Bunting
Phone: (248) 647-6000
Fax: (248) 647-5210
E-mail: bbunting@patlaw.com

Cleveland:

Sponsored by: Cleveland Public Library
Location: Louis Stokes Wing Auditorium
Date/Time: Monday, May 21, 9:00 a.m. - 4:30 p.m.
Tuesday, May 22, 9:00 a.m. - 4:30 p.m.
Contact: 216/623-2870 (phone)
216/623-7030 (fax)
e-mail: robin.gray@cpl.org
(please include "patent workshop registration" in subject)

St. Louis:

Sponsored by: St. Louis Public Library
Location: Business, Science & Technology
Date/Time: Monday, June 4, 9:00 a.m. - 4:30 p.m.
Tuesday, June 5, 9:00 a.m. - 4:30 p.m.
Contact: 314/539-0390
cgiles@slpl.lib.mo.us

Minneapolis/St. Paul:

Sponsored by: Minneapolis Public Library

Location: Technology/Science/Government Documents

Date/Time: Thursday, June 7, 9:00 a.m. - 4:30 p.m.

Friday, June 8, 9:00 a.m. - 4:30 p.m.

Contact: 612/630-6122

Orlando:

Sponsored by: University of Central Florida Libraries

Location: Orlando, FL

Date/Time: Monday, June 25, 9:00 a.m. - 4:30 p.m.

Tuesday, June 26, 9:00 a.m. - 4:30 p.m.

Contact: Peter Spyers-Duran

Reference Librarian

PO Box 162666

Orlando, FL 32816-2666

407/823-5880 (phone)

407/823-3438 (fax)

pspyers@mail.ucf.edu

Atlanta:

Sponsored by: Georgia Institute of Technology

Location: Library and Information Center

Date/Time: Thursday, June 28, 9:00 a.m. - 4:30 p.m.

Friday, June 29, 9:00 a.m. - 4:30 p.m.

Contact: Roland Garner

404/385-0380

roland.garner@library.gatech.edu

Additional information for USPTO's Patents Customer 2001 Program workshops is available on USPTO's Web site at www.uspto.gov (click on Patents Customer Outreach 2001 Program). The site will be updated with additional workshop locations as they are scheduled.

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